



Paper No. 5

CARRIER CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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SYRACUSE NY 13221

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OFFICE OF PETITIONS

In re Application of
Bush, et al.
Application No. 10/038,439
Filed: January 7, 2002
Attorney Docket No. 9997A
For: METHOD TO ROUGH SIZE
COATED COMPONENTS FOR EASY
ASSEMBLY

DECISION DISMISSING
PETITION

This is a decision on the petition under 37 CFR 1.182 and/or 1.183, filed April 16, 2002 (certificate of mailing date April 12, 2002), requesting that the above-identified application be accorded "...an earlier filing date but no later than December 28, 2001." The petition will be treated under 37 CFR 1.183.

The application was received in the Patent and Trademark Office (Office) on January 7, 2002. It was mailed by United States Postal Service (USPS) first class mail. Petitioners request a filing date of December 28, 2001 at the latest in order to maintain copendency with, and thereby claim benefit to, provisional application no. 60/259,064, filed December 28, 2000.

For grant of the relief sought in a petition under 37 CFR 1.183, petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Typically, a non-provisional application's filing date is the date upon which a specification, at least one claim, and drawings (if required) are filed in the Office. 37 CFR 1.53(b). This is the default rule. However, Public Law 97-247, 96 Stat. 317 (1982), amended 35 U.S.C. § 21 to permit, but not require, the Office to prescribe that any paper or fee required to be filed in the PTO be considered filed in the PTO on the date on which it was deposited with the USPS. While 35 U.S.C. 21 grants the Director the authority to consider any paper or fee filed in the PTO on the date the paper or fee was deposited with the USPS, the Director has specifically refused to exercise that authority in favor of mail other than Express Mail. Express Mail receives preferential treatment over all other types of mail. A paper filed in compliance with 37 CFR 1.10 will be considered as filed on the date the paper was deposited with the USPS in Express Mail service. Applications filed by types of mail other than Express Mail receive a filing date as of receipt in the Office.

The "extraordinary circumstances" rationale does not apply in petitioners' situation because petitioners could have filed the application via Express Mail service. Petitioners state that they chose not to rely on the provisions of 37 CFR 1.10 because they believed the application would arrive in the Office prior to December 28, 2001. Circumstances resulting from applicants' failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of extraordinary relief. *See In re Tetrafluor, Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); *In re Bird & Son, Inc.* 195 USPQ 586, 588 (Comm'r Pats. 1977); *Huston v. Ladner*, 23 USPQ2d 1910 (Fed. Cir. 1992); *Vincent v. Mossinghoff*, 230 USPQ 621, 625 (D.D.C. 1985). A party's failure to comply with the requirements of Rule 10 is not an extraordinary circumstance that would warrant waiver. *See Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994).

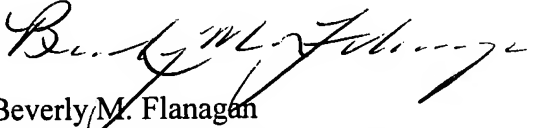
The evidence presented indicates that petitioners were aware that the application had to be filed no later than December 28, 2001 in order to obtain the benefits available under 35 U.S.C. 119(e) based on petitioners' prior provisional application No. 60/259,064. The application could have been accorded a filing date of or prior to December 28, 2001 under 37 CFR 1.10. Although petitioners knew the importance of obtaining a filing date of or prior to December 28, 2001, there was a failure on petitioners part to mail the application in a manner necessary to insure the desired filing date.

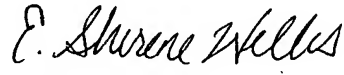
A reasonable person acting with due care and diligence would have filed the application in compliance with 37 CFR 1.10 to ensure its timely filing in the PTO. *Krahn v. Commissioner of Patents and Trademarks*, 15 U.S.P.Q.2d (BNA) 1823 (E.D. Va. 1990).

Accordingly, the petition is **dismissed**.

The application is being forwarded to Technology Center Art Unit 3744 with the presently accorded filing date of January 7, 2002 for examination in due course.

Any inquiries pertaining to this matter may be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.


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